REMARKS

This responds to the Office Action mailed on December 21, 2005. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-28 are now pending in this Application.

§103 Rejection of the Claims

Claims 1-6 and 8-28 were rejected under 35 USC § 103(a) as being unpatentable over Jagadeesan et al. (U.S. 2005/0059400; hereinafter "Jagadeesan") in view of Chen et al. (U.S. 6,606,485; hereinafter "Chen"). Claim 7 was also rejected under 35 USC § 103(a) as being unpatentable over Jagadeesan/Chen and further in view of Petrus (U.S. 2004/0266474; hereinafter "Petrus"). First, the Applicant does not admit that Jagadeesan, Chen, or Petrus are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facia* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

No proper *prima facie* case of obviousness has been established because (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

Combining References Does Not Teach All Limitations: First, with respect to independent claims 1, 6, 15, 20, and 24, no combination suggested in the Office Action will render all of the claim limitations. The Office admits Jagadeesan fails to disclose "downloading a demodulation code" or "a module to download a demodulation code", as claimed by the Applicant. Chen and Petrus have the same deficiency.

While the assertion is made in the Office Action that Chen discloses "downloading a demodulation code" at Chen, col. 8, lines 24-50 and col. 11, lines 17-28, a close reading of Chen reveals that this is incorrect. Chen describes the reception of code symbols on several channels. In fact, Chen describes the duplicate reception of code symbols over several channels "to avoid interference and fading ...," which implies that the demodulators used on the channels are the same. *See* Chen, Col. 8, lines 48-49. Therefore, Chen discloses transmitting/receiving code

symbols, and nothing whatever to suggest or teach downloading "a demodulation code" as claimed by the Applicant.

With respect to the assertion by the Office that the Blakeney reference, cited by Chen, is "not pertinent to the instant application since it merely discloses non-limiting examples of the searchers and demodulators of Chen ...," the Applicant respectfully disagrees. The Blakeney reference forms an integral part of Chen, and should be considered by the Examiner when interpreting the scope of the teaching of the Chen reference. Otherwise, no meaningful interpretation can be given to the terms used by Chen. As noted in a previous response, given that the demodulation units of Blakeney are held up as being examples of the searchers and demodulators units 130, 230 taught by Chen, it is clear that the demodulators included in Chen's searchers and demodulators units 130, 230 are identical. Thus, Chen provides no need to download any demodulation codes, nor is any such activity described. This is why the Applicant was unable to find any support in Chen for "downloading a demodulation code" or "a module to download a demodulation code", as claimed by the Applicant. It is respectfully noted that references must be considered in their entirety, including parts that teach away from the claims. See MPEP ' 2141.02.

Neither has the Office alleged that Petrus includes this missing element, and no evidence was found by the Applicant to the contrary. Therefore no combination of Jagadeesan, Chen, or Petrus can provide these claimed elements, and independent claims 1, 6, 15, 20, and 24 are nonobvious. This conclusion applies with even greater force respecting all of the dependent claims since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

No Motivation to Combine References: The Office asserts that it would be obvious to combine Jagadeesan with Chen "to download the demodulation code of Jagadeesan as suggested by Chen." However, this assertion overlooks the fact that Jagadeesan and Chen teach away from such a combination.

First, the mobile station 12 of Jagadeesan "includes dual-mode technology to support the transition from one network to another." Jagadeesan, para. 14. The Applicant could find no mention of a way to download demodulation code into the mobile station 12 of Jagadeesan. In addition, since Jagadeesan's dual-mode technology is already present in the mobile station 12,

there is no motivation to download demodulation code – the required elements to hand off a call between networks is already present.

Second, Chen does not suggest downloading demodulation code, contrary to the assertion of the Office Action. As noted above, the demodulators included in Chen's searchers and demodulators units 130, 230 are identical, and there is no need to download any code. Further, the Applicant was unable to find any mention of downloading demodulation codes in Chen. The portion of Chen cited by the Office (Chen, Col. 8, lines 24-50 and Col. 11, lines 17-28) merely describes the general nature of the demodulation process – downloading codes is not taught or suggested. Adding Petrus to the combination of Jagadeesan and Chen does nothing to remedy this deficiency.

Third, while the Office asserts that Jagadeesan teaches a memory 44 that has code 56, including "logic routines for implementing wireless communication protocols" there is no teaching whatsoever with respect to downloading a demodulation code. *See* Jagadeesan, para. [0030]. For example, the code described by Jagadeesan may well be installed as part of a programmable read-only memory that is never changed after laving the factory. Nothing in Jagadeesan indicates otherwise.

The Examiner must avoid the use of hindsight. *M.P.E.P.* ' 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). In other words, the Examiner cannot use the Applicant=s structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman,* 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

It is respectfully noted that references must be considered in their entirety, including parts that teach away from the claims. See MPEP ' 2141.02. Since Jagadeesan and Chen teach away from combination, there is no motivation to combine the references.

Finally, the use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2). The assertion by the Office that "the obvious combinations are indeed supported since ... motivation to do so is found either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art" is unavailing, since the references do not provide this motivation, as demonstrated above, and no information regarding knowledge generally available to one of ordinary skill in the art exists in the record.

No Reasonable Expectation of Success: Modifying Jagadeesan to implement the asserted download activity of Chen will not provide an operative combination, since Chen does not teach downloading demodulation code. Adding Petrus to this combination does nothing to remedy the deficiency that results. The Office does not address this argument, made in the previous response.

Again, the use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

The test for obviousness under ' 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. ' 2143.01.

Therefore, since there is no evidence in the record that combining Jagadeesan, Chen, or Petrus results in apparatus or methods that operate to download demodulation codes, as claimed by the Applicant; since there is no motivation to supply the missing elements (because the references teach away from such a combination); and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 6, 15, 20 and 24, or for any of the claims that depend from them. It is therefore respectfully requested that the rejections of claims 1-28 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677, or Applicant's below-named representative to facilitate the prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of February 2006.

Chris Hammond
Name

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Signature